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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,900	11/15/1999	BRUCE K. WINKER	93SC024RE	4426

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EXAMINER	
DUDEK, JAMES A	

ART UNIT	PAPER NUMBER
2871	

DATE MAILED: 05/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/447,900	WINKER, BRUCE K.	
	Examiner	Art Unit	
	James A. Dudek	2871	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-7 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-7 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are rejected under the judicially created doctrine of double patenting over claim 8 of U. S. Patent No. 5,504,603 ("603") and claim 35 of U.S. Patent No. 6,320,634 ("634") since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Reissue claims and 603

Claim 1 of the reissue application claims a monolithic compensator for a liquid crystal display comprising: (a) a first deposited thin-film positively birefringent O-plate compensator layer having a first surface; (b) a second thin-film compensator layer deposited onto said first surface of said first compensator layer, wherein said second deposited thin-film compensator

layer is selected from the group consisting of (i) a positively birefringent O-plate compensator layer, (ii) a positively birefringent A-plate compensator layer, (iii) a negatively birefringent A-plate compensator layer, and (iv) a negatively birefringent C-plate compensator layer.

The limitation of 603 claim 8 which correspond to the reissue claim are "a compensator, including: a positively birefringent O-plate compensator layer disposed between the polarizer layer and the liquid crystal layer with its optic axis oriented at a substantially oblique angle of between 25 and 65 degrees with respect to the normal axis; a first positively birefringent A-plate compensator layer disposed between the polarizer layer and the O-plate layer; and a second positively birefringent A-plate compensator layer disposed between the O-plate layer and the liquid crystal layer, the first and second A-plate layers being oriented with their optic axes relative to the optic axis of the O-plate layer such that retardation of light passing through the compensator at normal incidence is minimized.
" [Emphasis added.]

Lacking from the 603 claims are the films being deposited. However, this is a product by process limitation. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

Furthermore, 603 claims additional element not found in claim 1 of the reissue application. However, the omission of the additional elements would have been obvious to one of ordinary skill at the time of invention as it was well known to the manufacture stock compensators for sale without the other elements necessary to make a display.

Claim 2 of the reissue application claims the monolithic compensator of claim 1, wherein one or more thin-film layers of material are deposited between said first deposited thin-film compensator layer and said second deposited thin-film compensator layer. This limitation corresponds to "a first positively birefringent A-plate compensator layer disposed between the polarizer layer and the O-plate layer" of 603

Claim 3 of the reissue application claims the monolithic compensator of claim 2, wherein at least one of said one or more thin-film layers is a deposited thin-film compensator layer. This is a product by process limitation.

Claim 4 of the reissue application claims a liquid crystal display comprising: (a) a polarizer layer; (b) an analyzer layer; (c) a liquid crystal cell having a first transparent substrate and a second transparent substrate forming respective walls of said liquid crystal cell, said liquid crystal cell disposed between said polarizer layer and said analyzer layer; and (d) a monolithic compensator in accordance with a specified one of claims 1, 2, or 3 disposed between said polarizer layer and said analyzer layer. These limitations are clearly claimed in claim 8 of 603.

Claims 5-7 of the reissue application claims a compensator element for a liquid crystal display comprising: (a) an optically transparent substrate; and (b) a monolithic compensator in accordance with a specified one of claims 1, 2, and 3, operatively coupled to a optically transparent substrate, wherein said optically transparent substrate is an optical polarizer and said optically transparent substrate is one surface of a liquid crystal cell. These limitations are also clearly claimed in claim 8 of 603.

Reissue claims and 634

Claim 1 of the reissue application claims a monolithic compensator for a liquid crystal display comprising: (a) a first deposited thin-film positively birefringent O-plate compensator layer having a first surface; (b) a second thin-film compensator layer deposited onto said first surface of said first compensator layer, wherein said second deposited thin-film compensator layer is selected from the group consisting of (i) a positively birefringent O-plate compensator layer, (ii) a positively birefringent A-plate compensator layer, (iii) a negatively birefringent A-plate compensator layer, and (iv) a negatively birefringent C-plate compensator layer.

The limitation of 634 claim 35 which correspond to the reissue claim are "a first positively birefringent O-plate compensator layer disposed between the polarizer layer and the analyzer layer, wherein the first O-plate layer comprises a liquid crystal polymer of a photopolymerized material with its optical symmetry axis oriented at an oblique tilt angle with respect to a major surface of the first O-plate layer; a second positively birefringent O-plate

compensator layer disposed between the polarizer layer and the analyzer layer, wherein the second O-plate layer comprises a liquid crystal polymer of a photopolymerized material with its optical symmetry axis oriented at an oblique tilt angle with respect to a major surface of the second O-plate layer; and a positively birefringent A-plate compensator layer disposed between the polarizer layer and the analyzer layer," [Emphasis added.]

Furthermore, 634 claims additional element not found in claim 1 of the reissue application. However, the omission of the additional elements would have been obvious to one of ordinary skill at the time of invention as it was well known to the manufacture stock compensators for sale without the other elements necessary to make a display.

Claim 2 of the reissue application claims the monolithic compensator of claim 1, wherein one or more thin-film layers of material are deposited between said first deposited thin-film compensator layer and said second deposited thin-film compensator layer. This limitation corresponds to "a second positively birefringent O-plate compensator layer disposed between the polarizer layer and the analyzer layer" of 634

Claim 3 of the reissue application claims the monolithic compensator of claim 2, wherein at least one of said one or more thin-film layers is a deposited thin-film compensator layer. This is a product by process limitation.

Claim 4 of the reissue application claims a liquid crystal display comprising: (a) a polarizer layer; (b) an analyzer layer; (c) a liquid crystal cell having a first transparent substrate and a second transparent substrate forming respective walls of said liquid crystal cell, said liquid crystal cell disposed between said polarizer layer and said analyzer layer; and (d) a monolithic compensator in accordance with a specified one of claims 1, 2, or 3 disposed between said polarizer layer and said analyzer layer. These limitations are clearly claimed in claim 35 of 634.

Claims 5-7 of the reissue application claims a compensator element for a liquid crystal display comprising: (a) an optically transparent substrate; and (b) a monolithic compensator in accordance with a specified one of claims 1, 2, and 3, operatively coupled to a optically transparent substrate, wherein said optically transparent substrate is an optical polarizer and said optically transparent substrate is one surface of a liquid crystal cell. These limitations are also

clearly claimed in claim 35 of 634 as the films are layered between the polarizer, analyzer and one the films is a liquid crystal polymer.

The prior art of record, save the patents used to rejected under the double patenting doctrine, teach a monolithic compensator for a liquid crystal display comprising: (a) a first deposited thin-film compensator layer having a first surface; (b) a second thin-film compensator layer deposited onto said first surface of said first compensator layer, wherein said second deposited thin-film compensator layer is selected from the group consisting of (i) a positively birefringent A-plate compensator layer, (ii) a negatively birefringent A-plate compensator layer, and (iii) a negatively birefringent C-plate compensator layer. The prior art of record does not teach nor suggest in combination with the limitation supra, a first deposited thin-film positively birefringent O-plate compensator layer having a first surface.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Dudek whose telephone number is 571-272-2290. The examiner can normally be reached on 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert H. Kim can be reached on 571-272-2293. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James A. Dudek
Primary Examiner
Art Unit 2871